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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,422	08/02/2001	Mun Leong Wong	70007938-2	7468

7590 11/22/2004

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EXAMINER	
LEE, PHILIP C	
ART UNIT	**PAPER NUMBER**
2154	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,422	WONG ET AL.	
	Examiner	Art Unit	
	Philip C Lee	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *11 and 13* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/8/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-10 and 12 are presented for examination.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10 and 12, Group I, drawn to a process for accessing remotely stored data, classified in class 709, subclass 217.

II. Claims 11 and 13, Group II, drawn to a process of managing email attachments, classified in class 709, subclass 206.

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as content arrangement of streaming and static contents; this is a patentable distinct feature not found in invention I. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and search for Groups II is not required for Group I, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Denny Trueman on 11/05/04 a provisional election

was made without traverse to prosecute the invention of group I, claims 1-10 and 12. Affirmation of this election must be made by applicants in replying to this office action. Claims 11 and 13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections – 35 USC 112

6. Claims 1-10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim language in the following claims is not clearly understood:

i. As per claim 1, lines 4-6, it is unclear if "as an instruction" refers to designating a first piece of data to be transferred or refers to as a first piece of data [i.e. the clause may means "designating a first piece of data to be transferred and the target computer system to which the first piece of data is to be transferred" as an instruction or "to which the first piece of data is to be transferred as an instruction".].

ii. As per claim 12, lines 10-12, it has the same uncertainty as claim 1 above.

Claim Rejections – 35 USC 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1, 5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Singhal, U.S. Patent 6,256,666 (hereinafter Singhal).

10. As per claim 1, Singhal taught the invention as claimed for using a mobile device to transfer one of a plurality of data being stored in a sub-computer system to an target computer system, comprising:

designating a first piece of data to be transferred (e.g. message ID)and the target computer system to which the first piece of data is to be transferred (e.g. printer named Oak)as an instruction in the mobile device (col. 5, lines 8-16, 40-49); (Note that an instruction is interpreted as designating the data to be transferred and the target computer system to which the first piece of data is to be transferred.)

sending the instruction from the mobile device to a central computer system (e.g. Mobile Access Gateway with extended Mobile Message Processor) via a first network (col. 5, lines 14-16; col. 6, lines 3-5);

informing the sub-computer system of at least part of the instruction by the central computer system (col. 6, lines 43-45); (It is inherent that the email server must be informed of the message ID in order to retrieve the desired message.) and

transmitting the first piece of data from the sub-computer system to the target computer system via a second network according to the instruction (col. 5, lines 47-49; col. 7, lines 49-54). (Note that the claim is interpreted as transmitting the first piece of data from the sub-computer system to the target computer system through indirect routing instead of transmission between the sub-computer and target computer system directly.)

11. As per claim 5, Singhal taught the invention as claimed in claim 1 above. Singhal further taught that an identification of the target computer system is known to the central computer system, and wherein the step of designating the target computer system includes specifying its identification in the instruction (col. 5, lines 47-49).

12. As per claim 8, Singhal taught the invention as claimed in claim 1 above. Singhal further taught comprising

composing a first piece of information in the mobile device (col. 5, lines 8-16);

transmitting the first piece of information from the mobile device to the central computer system via the first network (col. 5,lines 13-25);

generating a file in the central computer system by combining the first piece of information with the first piece of data retrieved (col. 5, lines 55-57; col. 6, lines 43-45); and

transmitting the file to the target computer system (col. 7, lines 49-54).

Claim Rejections – 35 USC 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal.

15. As per claim 6, although Singhal did not specifically detailing the location of the first piece of data in the instruction, however, Singhal taught designating the first piece of data in the instruction (e.g. message id) for retrieval of data (col. 6, lines 43-45). Therefore, It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include the location of the first piece of data in the instruction because by doing so it would increase the retrieval time in Singhal's system.

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal in view of Official Notice.

17. As per claim 7, although Singhal did not specifically teach including the target computer's internet protocol address in the instruction, however, official notice is taken that the concept of designating a receiver by specifying the receiver's internet protocol address is known and accepted in the art (e.g., designating destination IP address in packet header). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include the destination Internet protocol address in the instruction to enable routing of information in the Internet.

18. Claims 2-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal in view of Peng, U.S. Patent 6,816,944 (hereinafter Peng).

19. As per claim 2, Singhal taught the invention as claimed in claim 1 above. Singhal did not specifically teach storing and sending information relating to identifications of the data in the central computer system (e.g. Mobile Access Gateway with extended Mobile Message Processor). However, in the same field of endeavor, Peng taught a method comprising:

storing information relating to identifications of the plurality of data (e.g. data set URL) in the central computer system (e.g. gateway) (col. 14, lines 5-10); and

sending said information from the central computer system to the mobile device for designating the first piece of data (col. 15, lines 40-45).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Singhal and Peng because Peng's method of storing information relating to identification of the plurality of data would improve the communication traffic and efficiency of Singhal's system by caching frequently used data set in the gateway to a mobile device (col. 14, lines 1-5).

21. As per claim 3, Singhal and Peng taught the invention substantially as claimed in claim 2 above. Peng further taught using the mobile device to request the central computer system to send said information (col. 14, lines 10-13).

22. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Singhal and Peng because Peng's method of

requesting information by the mobile device would increase the flexibility of the user by allowing the user of the mobile device to request information according to the user's needs.

23. As per claim 12, Singhal taught the invention substantially as claimed for using a mobile device to transfer one of a plurality of data being stored in a sub-computer system to an target system, comprising:

designating a first piece of data to be transferred by using said information and the target computer system to which the first piece of data is to be transferred as an instruction in the mobile device (col. 5, lines 8-16, 40-49); (Note that an instruction is interpreted as designating the data to be transferred and the target computer system to which the first piece of data is to be transferred.)

sending her instruction from the mobile device to the central computer system via the first network (col. 5, lines 14-16; col. 6, lines 3-5);

informing the sub-computer system of at least part of the instruction by the central computer system (col. 6, lines 43-45); (It is inherent that the email server must be informed of the message ID in order to retrieve the desired message.) and

transmitting the first piece of information from the sub-computer system to the target computer system according to the instruction (col. 5, lines 47-49; col. 7, lines 49-54). (Note that the claim is interpreted as transmitting the first piece of data from the sub-computer system to the target computer system through indirect routing instead of transmission between the sub-computer and target computer system directly.)

24. Singhal did not specifically teach storing and sending information relating to identifications of the data in the central computer system (e.g. Mobile Access Gateway with extended Mobile Message Processor). Peng taught the invention substantially as claimed comprising:

storing information relating to identifications of the plurality of data (e.g. data set URL) in a central computer system (e.g. gateway) (col. 14, lines 5-10);

using the mobile device to request the central computer system to send said information to the mobile device via a first network (col. 14, lines 10-13); and

sending said information from the central computer system to the mobile device via the first network (col. 15, lines 40-45).

25. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Singhal and Peng because Peng's method of storing information relating to identification of the plurality of data would improve the communication traffic and efficiency of Singhal's system by providing frequently used data set cached in the gateway to a mobile device more quickly (col. 14, lines 1-5).

26. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal in view of Keeney et al, U.S. Patent 6,748,471 (hereinafter Keeney).

27. As per claim 4, Singhal taught the invention as claimed in claim 1 above. Singhal further taught comprising:

sending the first piece of data from the sub-computer system to the central computer system according to said part of the instruction (col. 6, lines 43-45);

saving the first piece of data under a filename in the central computer system (col. 5, lines 55-57).

Singhal did not teach informing the target computer of the filename by the central computer system and downloading the data by the target computer according to the filename. Keeney taught a similar system comprising:

informing the target computer system of the file name by the central computer system (col. 12, lines 41-49); and

downloading the first piece of data from the central computer system by the target computer system according to the filename (col. 7, lines 35-38; col. 12, lines 41-49).

28. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Singhal and Keeney because Keeney's of informing the target device of the filenames would increase the system alertness in Singhal's system by notifying the user of the available documents for download (col. 12, lines 50-55).

29. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal in view of Sragner, U.S. Patent 6,272,485 (hereinafter Sragner).

30. As per claim 9, Singhal taught the invention as claimed in claim 1 above. Singhal did not teach that the target computer is designated by an email address. Sragner taught designating a recipient by specifying an email address relating to the recipient (col. 6, lines 48-57).

31. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Singhal and Sragner because Sragner's teaching of specifying an email address would increase the functionality of Singhal's system by enabling data to be routed to the recipient as electronic message.

32. As per claim 10, Singhal and Sragner taught the invention substantially as claimed in claim 9 above. Sragner further taught wherein the step of generating the file includes attaching the first piece of data within the email (col. 6, lines 48-57).

CONCLUSION

33. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)350-6121.

11/10/04

P.L.